

### **REMARKS**

Claims 3, 4, 6, 7, 10 and 11 are now present in this application. Claims 3, 6 and 7 are independent.

Claims 3, 6 and 7 have been amended. Reconsideration of this application, as amended, is respectfully requested.

#### **Reasons for Entry of Amendments**

At the outset, it is respectfully requested that this Amendment be entered into the Official File in view of the fact that the amendments to the claims place the application in condition for allowance.

The Amendment returns the claims to their form before the response of October 4, 2010. The Examiner rejected these claims over the term “readily,” which is addressed in the following remarks.

In the alternative, if the Examiner does not agree that this application is in condition for allowance, it is respectfully requested that this Amendment be entered for the purpose of appeal. This Amendment reduces the issues on appeal by placing the claims in compliance with 35 U.S.C. § 112, 2nd Paragraph. This Amendment was not presented at an earlier date in view of the fact that Applicants did not fully appreciate the Examiner's position until the Final Office Action was reviewed.

#### **Rejection under 35 U.S.C. § 112, 2nd Paragraph**

Claims 3, 4, 6, 7, 10 and 11 stand rejected under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph. This rejection is respectfully traversed.

The Examiner has set forth certain instances wherein the claim language is not clearly understood.

In order to overcome this rejection, Applicants have amended claims 3, 6 and 7. Applicants respectfully submit that the claims, as amended, particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

In *Hearing Components, Inc. v. Shure Inc.*, 94 USPQ2d 1385; 600 F.3d 1357 (CAFC, Apr. 1, 2010), the Federal Circuit reversed the district court's determination that claims 1 and 2 of U.S. Patent No. 5,401,920 ("the '920 patent") were invalid as indefinite.

With respect to the '920 patent, the Federal Circuit reversed the district court's determination. As an initial matter, the Court determined that, although the phrase "readily installed and replaced by a user" occurs in the claim preamble, it is nevertheless a claim limitation because it was relied upon to distinguish prior art and is not duplicative of other language in the claim.

"Not all terms of degree are indefinite. . . . [A] court must determine whether the patent's specification supplies some standard for measuring the scope of the phrase." (quoting *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1351 (Fed. Cir. 2005).

However, the Court determined that this limitation is not indefinite. The Court explained that while the claim term "readily" was a term of degree lacking "mathematical precision," the patent's specification nevertheless provides an adequate standard for measuring the scope of the phrase. For example, the '920 patent explains that the "readily installed and replaced wax guard" is "inexpensive and requires no tools for installation or removal." The '920 patent also provides prior art examples of hearing aids having wax guards that were difficult to remove or replace, which define the boundary of the claim by negative implication.

The district court was also correct in noting that the specification discusses the phrase "readily installed and replaced by a user" in the context of prior art. The specification disparages prior art guards that were not "readily installed and replaced."... By negative implication, the patent thus explains that a filter that must be mounted beyond the sound delivery tube opening is not "readily installed and replaced."

In the present specification, paragraphs [0039] and [0040] of the specification provide context to the phrase "readily abraded or separated" so that a standard for measuring the scope of the phrase is established.

#### **Rejections under 35 U.S.C. § 103**

Claims 3, 4, 6, 7, 10 and 11 stand rejected under 35 U.S.C. § 103 as being obvious over van Rooji in view of Urata. These rejections are respectfully traversed.

Complete discussions of the Examiner's rejections are set forth in the Office Action, and are not being repeated here.

Independent claims 3, 6 and 7 recite a "readily abraded coating." The meaning of the phrase "readily abraded" can be ascertained by a reading of the specification, which provides a standard for measuring the scope of the phrase, as explained above with regard to the rejection based on indefiniteness. The Examiner states that van Rooji discloses a chain having a plurality of link plates including through holes. The Examiner recognizes that van Rooji does not disclose a coating material and relies upon Urata for allegedly disclosing a coating that is readily abraded and concludes that it would have been obvious to use the coating of Urata with the chain of van Rooji. Applicants respectfully traverse this rejection.

The Examiner states that Urata discloses a zinc-phosphate coating subject to wear and thus, can be said to be capable of being readily abraded or separate, at least to some degree. The Examiner's statement is contradictory, as it states the coating is readily abraded to some extent. As set forth in the specification, the coating material is "readily abraded in a small number of flexions" (paragraph [0039], page 26) and the coating material "are more prone to abrade than the material constituting the link plate 2, such as carbon steel, or have such a low adhesion as to easily abrade." (paragraph [0041], page 28).

Applicants respectfully submit that the specification supplies some standard for measuring the scope of the phrase "readily abraded" and that the prior art does not disclose a coating that is readily abraded.

Applicants respectfully submit that the combinations of elements as set forth in independent claims 3, 6 and 7 are not disclosed or made obvious by the prior art of record, including van Rooji and Urata, for the reasons explained above. Accordingly, reconsideration and withdrawal of these rejections are respectfully requested.

With regard to dependent claims 4, 10 and 11, Applicants submit that claims 4, 10 and 11 depend, either directly or indirectly, from independent claim 3 which is allowable for the reasons set forth above, and therefore claims 4, 10 and 11 are allowable based on their dependence from claim 3. Reconsideration and allowance thereof are respectfully requested.

**Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Christopher J. McDonald, Registration No. 41,533, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: March 18, 2011

Respectfully submitted,

By 

Paul C. Lewis *cjm*

Registration No.: 43,368

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, VA 22040-0747

703-205-8000